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EXAMINER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/782,794  
Filing Date: February 23, 2004  
Appellant(s): BOEDER, MARK ROLAND

\_\_\_\_\_  
Roger W. Parkhurst, Esq.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 5, 2008 appealing from the Office action mailed April 3, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Upov-rom Plant Variety Database for European Plant Breeder's Right application number 011850 published on February 15, 2002 with regard to Chrysanthemum plant named 'Cetwotone Pink', one page.

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Royal Horticultural Society Dictionary of Gardening 1992, vol. 1, pp. 614-618.

Karim et al. "Rapid Multiplication of Chrysanthemum morifolium through in vitro culture",  
Pakistan Journal of Biological Sciences 5(11): (2002) pp. 1170-1172.

EconPort, "Dutch Auction", Internet

[http://www.econport.org:8080/econport/request?page=man\\_auctions\\_dutchauction](http://www.econport.org:8080/econport/request?page=man_auctions_dutchauction) retrieved  
8/22/05, 2 pp. (filed on August 25, 2005).

Chrysanthemum Breeders Association, Sales, Internet <http://www.cba-nv.nl/index.cfm?act=Agenten.default>, retrieved 8/22/05, one page (filed on August 25, 2005).

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 is rejected under 35 U.S.C. 102(b). This rejection is set forth in a prior Office Action dated April 3, 2007. The rejection is summarized below:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the European Plant Breeder's Right (PBR) application number 011850 published on February 15, 2002, more than one year prior to the filing date of the instant application in view of Applicant's admission that the

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instant cultivar was first sold in August 2002 at a flower auction in the Netherlands (reply dated January 24, 2005) and the Royal Horticultural Society Dictionary of Gardening 1992, vol. 1 (RHS) describing how to asexually propagate a chrysanthemum plant.

The European PBR was published on February 15, 2002, more than one year prior to the filing date of this instant application. A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re Le Grice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could obtain or reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether 'Siokra' seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the cultivar Siokra disclosed in the cited publications.").

Appellant has admitted that 'Cetwotone Pink' was first placed on sale in The Netherlands on August 2002 when flowers were offered for sale at the Flower Auction (Remarks filed on January 24, 2005, page 3). The trade designation of this variety was 'Twotone Pink' (Remarks filed on January 24, 2005). The sale of the plant was not a single solitary occurrence and one of ordinary skill in the art would have been able to obtain the plant. Plant auctions in The Netherlands are closely followed by those of ordinary skill in the art. Evidence of the economic importance is cited under "Applications" of the "EconPort" web site <http://www.econport.org:8080/econport/request?page=man-auctions> dutchauction. Almost  $\frac{3}{4}$  of The Netherlands total export of horticultural products in 2002 consisted of flowers and plants sold at Dutch flower auctions.

Knowledge of how to asexually propagate chrysanthemum was commonly known to one of ordinary skill in the art as evidenced by page 614 of the RHS reference that states that propagation of chrysanthemums is invariably "from softwood basal growths" (page 614, column 1, second full paragraph). The next two paragraphs expand on propagation techniques. As a result, this rejection meets the criteria set out by *In re Elsner* that the sale not is an isolated occurrence and that one of ordinary skill would have known how to propagate the instant plant.

Chrysanthemum may also be propagated from tissue culture (Karim et al., 2002). As a result, it would have been within the capability of one of ordinary skill in the art to propagate chrysanthemum even if only cut flowers and foliage was available. The references section of Karim et al. lists several publications detailing the tissue culture of chrysanthemum. Examples are Ben-Jaacov et al., Battacharya et al., Hoque et al., and others. Clearly, one of ordinary skill in the art would have been able to reproduce the instant plant more than one year prior to the filing date regardless of what type of tissue was available, e.g. whole plants, or cut flowers and foliage.

However, this case is different from *Elsner* in the sense that a name change has occurred: 'Two tone Pink' as opposed to 'Cetwotone Pink' or a breeder's reference number. This, in no way, has limited the ability of one of ordinary skill to obtain the plant. One of ordinary skill could have contacted the breeder at the address listed on the publication or as listed on the internet or other avenue (see for example a list of contact telephone numbers and addresses at <http://www.cba-nv.nl/index.cfm?act=Agenten.default>). The address for the plant breeders right is stated as "Chrysanthemum Breeders Association N.V., Abraham Mendes Chumaceiro Boulevard 11, Willemstad-Curacao, AN" alternatively, "Postbus 370, 1430 AJ Aalsmeer, The Netherlands." Thus, one of ordinary skill in the art would have been able to obtain the plant even if the plant was not present at the auction. These facts are not contested by Appellant nor

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has Appellant explained why one of ordinary skill in the art would not have been able to obtain the plant by contacting the breeder. Once the breeder is contacted, the breeder would have informed the purchaser under what name the plant was currently being sold and where to buy it, or they would have sold it themselves.

Plants are commonly marketed using a different name than that found in a patent. Trade names are commonly given to plants once they are sold, or as in the instant case, plants are sometimes marketed as a group and given a group name. Just because the name is changed does not affect the fact that the plant was publicly available. One of ordinary skill in the art still would have been able to obtain the plant and reproduce it as well. A person of ordinary skill in the art at the time the invention was made would have known to contact the breeder, whose contact information is listed on the Plant Breeder's Right application, and ascertain that the plant was being sold under a particular name as well as from where to buy or otherwise obtain the plant. It is deemed that a name change does not in any way limit the plant from being obtained and reproduced and as such, the rejection under 35 U.S.C. 102(b) would still apply. The requirement made in *In re Elsner* was that one of ordinary skill in the art must be able to reproduce the claimed plant and that the claimed plant needed to be accessible. Propagation of chrysanthemum is well known in the art as discussed above and the claimed plant was available to the public in 2002.

The publication cited above discloses the claimed variety. The foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. Appellant's admission that 'Cetwotone Pink' was sold in The Netherlands August 2002, more than one year prior to the filing date of this instant application does not appear to be an obscure or isolated occurrence that would go unnoticed by those skilled in the art. Appellant has not argued that the sale was obscure or isolated. With regard to the reproducibility of the instant plant the RHS

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reference describes how to asexually reproduce a chrysanthemum plant. As a result, one of ordinary skill in the art could have purchase the instant plant and asexually propagated it, thus reproducing the instant plant without undue experimentation. Therefore, the claim is anticipated by the published PBR application.

#### **(10) Response to Argument**

**Appellant argues** that sale of the plant outside of the United States does not qualify as prior art under 35 U.S.C. 102 (pp. 3-4 of brief).

This argument is not found persuasive because the rejection is based on a printed publication, not the public use/on sale. The printed publication bar applies no matter where the publication was made. Public availability of the plant shows that the publication was “enabled”. The sale or public availability of the plant is the secondary evidence that the primary reference is an “enabled disclosure” (See MPEP 2131.01). *In re Samour* and *In re Donohue* both say that other evidence can be used to show that the publication was enabled. In *Donohue*, 226 USPQ 622 the Courts state, “The purpose of citing Lincoln and Wagner is, instead, to show that the claimed subject matter, as disclosed in Nomura, was in the public’s possession. *Id.* Therefore, the anticipation rejection based on Nomura, Lincoln, and Wagner is proper.” *In re LeGrice* states, “public use and sale of a plant are the avenues by which a plant enters the public domain” (133 USPQ 371). Then *LeGrice* states, “The mere description of the plant is not necessarily an ‘enabling’ disclosure. Such descriptions, just as in the case of other types of inventions, in order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in the possession of those skilled.” In this case the claimed plant was sold in a public auction in 2002 and the PBR publication is enabled because of the availability of the claimed plant.



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**Appellant argues** that the sale outside of the U.S. is without any evidentiary basis and clearly erroneous and then cites a passage from Amgen Inc. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 65 USPQ2d 1385 (Fed. Cir. 2003) (p. 4 of brief).

This argument is not found persuasive because as stated above the rejection under 102(b) is over the published PBR document. The published PBR application is anticipatory because the foreign sale of the instant plant would enable one of ordinary skill in the art to make or reproduce the plant. Thus, the published document is enabled. *In re Elsner*, 381 F.3d 1125, 72 USPQ2d 1038 (CA FC 2004) states at p. 1039,

Plant Breeder's Rights applications published more than one year before effective filing dates of applications for plant patents are proper anticipatory references that may bar patentability of claimed plants under 35 U.S.C. § 102(b), even though PBR applications disclose claimed plant varieties but do not, by themselves, enable skilled artisan to practice claimed inventions or reproduce claimed plants, since public may have had access to claimed inventions through foreign sales of plants, from which claimed plants may be reproduced, and since secondary references may be used to show that primary Section 102(b) reference was in fact enabled; although foreign sales are not prior art, precise issue is whether publication of PBR applications placed claimed inventions in possession of public before critical date, and foreign sales of claimed plants may be within knowledge of skilled artisan and may be considered to provide public access to applicants' inventions.

As in this case, the PBR document was published more than one year prior to the filing date of this instant application and Appellant's admission of the sale of the instant plant, wherein the public had access to the plant. Then one of ordinary skill in the art could obtain the plant and asexually reproduce the plant. Therefore, the published PBR document is enabled.

**Appellant argues** that the instant plant cannot be produced without physical possession of the plant material in the United States, more than one year before the filing date of this instant application (p. 4 of brief).

This argument is not found persuasive because as stated above the 102(b) rejection is based on the PBR application published more than one year prior to the filing date of this plant

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application and combined with the admission of the sale of the instant plant anywhere in the world is evidence that the publication is enabled.

**Appellant argues** that plant material cannot be imported into the U.S. for use without a six-month quarantine period before public dissemination and use (pp. 4-5 of brief).

This argument is not found persuasive because as stated above the rejection is over the PBR publication. Moreover, the quarantine importation procedure has nothing to do with an enabled publication.

**Appellant continues to reiterate** that the sale outside of the U.S. is not prior art under any part of the 35 U.S.C. 102 and that there was no access to the plant in the U.S. more than one year before the filing date of this instant application (p. 5 of brief).

This argument is not found persuasive because the statutes of 35 U.S.C. 102(b) is divided into three parts: 1) invention patented, 2) printed publication anywhere, and 3) public use or sale in the U.S. The rejection in this instant application is based on the published PBR application publication and Appellant's admission the instant plant was for sale in The Netherlands in 2002, more than one year prior to the filing date of this instant application is evidence that the publication is enabled.

**Appellant argues** that the Office Actions dated January 26, 2006 and December 17, 2004 made reference to *In re LeGrice* and *Ex parte Thomson* 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992 and the Office Action dated August 25, 2005 and Advisory Action dated October 31, 2007 relied on *In re Elsner* do not provide evidentiary record that there was any possession of the plant in the U.S. to "enable" the PBR document (pp. 5-6 of brief).

This argument is not found persuasive with regard to *LeGrice* in the Office Actions, *LeGrice* was cited to show that the public availability or sales of the plant are ways in which plants enter the public domain and thus would enable the publication. The Court in *LeGrice*

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states at p. 378, "The mere description of the plant is not necessarily an 'enabling' disclosure. Such descriptions, just as in the case of other types of inventions, in order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in the possession of those skilled." In this case, the PBR publication describes the instant plant and the availability of the plant at a public auction would allow a person skilled in the art to have possession of the plant. Once a skilled person is in possession of the instant plant, he/she could have easily reproduced the plant because of the various methods of propagating a chrysanthemum as noted by the RHS reference.

With regard to *Thomson*, *Thomson* was cited in the Office Action to show that public availability of a plant could enable a reference. The Board in *Thomson* states on page 1621, "Such public accessibility to the claimed seeds would have enabled the skilled artisan to make and use the claimed cultivar, its seeds, etc." As in this case, the accessibility of the instant plant through sale at a plant auction would have enabled one of ordinary skill in the art to make/reproduce the instant plant.

With regard to *In re Elsner*, *Elsner* was relied on in the Office Action and Advisory Action to point out that published PBR application combined with the foreign sale of the plants, placed the instant plant in the possession of the public and thus, the PBR application is a proper 102(b) anticipatory reference that would bar patentability.

**Appellant argues** that the Board in *Thomson* erroneously stated that there was no basis to citing, "The issue is not whether...[the claimed invention]...was on public use or sale in the United States, but rather whether...[it]...was available to a skilled artisan anywhere in the world such that he/she could obtain... and make/reproduce...[it as]... disclosed in the cited publication" 24 USPQ 2d at 1620 (p. 7 of brief).

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This argument is not found persuasive. An issue in *Thomson* was whether the Siokra was on public use or sale anywhere in the world so that a person skilled in the art could make/reproduce the Siokra cultivar. The Board in *Thomson* found that the seeds of the Siokra cited in the publication were commercially available to the public more than one year prior to the filing date. As in this instant case one skilled in the art could have reproduced the claimed cultivar from the available source, thus enabling the PBR publication describing the plant.

**Appellant argues** that the Federal Circuit in *Elsner* conflicts with the CCPA in *LeGrice* in which the Federal Circuit in *Elsner* found §161 plant patent applications to be different from regular utility applications (p. 7 of brief).

This argument is not found persuasive because the Court in *Elsner* states, "We agree with the PTO that *LeGrice* decided only the narrow issue whether a printed publication of a plant patent that is not enabled is a statutory bar. That decision did not address the manner in which a publication may be enabled, and it did not decide whether other evidence such as the availability of an invention through foreign sales may be considered in determining whether a printed publication enables a skilled artisan to reproduce a claimed plant. In fact, there was no mention of sales in the *LeGrice* opinion. We therefore conclude that *LeGrice* left that issue open, and our decision today is not inconsistent with *LeGrice*." The Court in *Elsner* does not conflict with the CCPA in *LeGrice*.

**Appellant continues to argue** that the accessibility of the instant cultivar should be in the U.S. (p. 8 of brief).

This argument is not found persuasive because as stated above the basis of this rejection under §102(b) is the published PBR application dated more than one year prior to the filing date of this instant application; Appellant's admission that the instant cultivar was available to the public; and the reproducibility of the instant cultivar. With regard to the accessibility of the

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instant cultivar, this may occur anywhere in the world. Moreover, the accessibility of the instant cultivar was not an isolated occurrence that would go unnoticed by those skilled in the art because it was accessible to anyone at a public auction in the Netherlands in 2002. The Court in *Elsner* states at page 1043, "Similarly here. Just as the public had access to the microorganism in *Argoudelis*, so too might the public have had access through foreign sales to the plant varieties that Elsner and Zary claim."

**Appellant argues** the present rejection is incomplete because the alleged enablement by the disclosure of the PBR application is missing key facts 1) the published PBR application document is not enabling; 2) the instant cultivar was not sold or imported to the U.S. before Appellant's U.S. filing date; 3) no single cited reference among the published PBR application, the admitted foreign sale, or RHS dictionary would bar patentability; and 4) no showing by the PTO of any evidence of anyone of even ordinary skill in the art in the U.S. was able to make and use the instant plant (pp. 8-9 of brief).

This argument is not found persuasive because the published PBR application document is enabled because the instant cultivar was available to the public at an auction, wherein one of ordinary skill in the art could have reproduced the claimed plant without undue experimentation. With regard to the instant cultivar not being sold or imported into the U.S., this argument is irrelevant because the rejection is based on the published PBR document enabled by the availability of the instant cultivar at a public auction and the reproducibility of the claimed plant. With regard to the PTO having no evidence that anyone in the U.S. could have made or use the instant cultivar, this is not what this rejection is based. As stated above the rejection is the published PBR application combined with the accessibility of the claimed plant anywhere in the world and information describing how to asexually propagate a chrysanthemum plant would bar patentability.

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**Appellant finally argues** that 102(b) expressly identifies only the sale of the instant plant in this country and such has not been shown (p. 9 of brief).

This is not found persuasive because as stated above the rejection is based on the published PBR document combined with the availability of the instant cultivar at a public auction and the reproducibility of the claimed plant.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/June Hwu/

Conferees:

/Anne Marie Grunberg/

SPE, AU 1638 and 1661

/Bruce Campell/

Supervisory Patent Examiner, Art Unit 1648